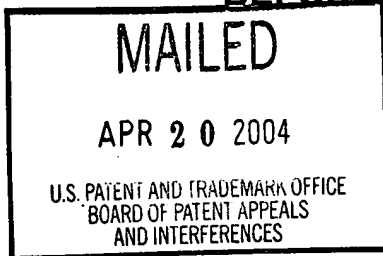


The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte RICHARD RUBIN

Appeal No. 2004-0940
Application No. 09/664,885

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 20,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to food storage devices and, more particularly, to containers for keeping food warm and moist (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief. The independent claims under appeal read as follows:

1. Apparatus for keeping food warm and moist comprising:
 - a pouch including a layer formed of a film of plastic material to provide water impermeability, the pouch being constructed to define an insulated and substantially water impermeable food warming chamber;
 - the pouch having opposing substantially coextensive lips defining a food passage into the food warming chamber;
 - the lips being formed to provide a passive, nonsealing engagement between the lips;
 - the passive, non-sealing engagement between the lips causing a partial enclosure of the warming chamber; and
 - the partial enclosure caused by the passive, nonsealing engagement between the lips and the food warming chamber being constructed to inhibit a build-up of moisture vapor produced from warm food disposed in the warming chamber for preventing warm food disposed in the warming chamber from becoming soggy and to allow enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist.
8. Apparatus for keeping food warm and moist comprising:
 - insulating structure supporting and substantially engulfing a substantially water impermeable plastic film pouch defining a food warming chamber for accommodating food;
 - the pouch and the insulating structure together providing generally opposing and substantially coextensive lips defining a food passage into the food warming chamber;
 - the lips being formed to produce a passive, nonsealing engagement between the lips;
 - the passive, non-sealing engagement between the lips causing a partial enclosure of the warming chamber; and
 - the partial enclosure caused by the passive, nonsealing engagement between the lips and the food warming chamber being constructed to provide a

partial vapor lock in the food warming chamber inhibiting moisture vapor produced from warm food disposed in the warming chamber from building up in the warming chamber, which prevents warm food disposed in the warming chamber from becoming soggy and allows enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist.

14. Apparatus for storing and keeping food warm and moist comprising:
a soft and flexible insulated pouch having a substantially water impermeable warming chamber and lips;
a non-sealing engagement between the lips causing a partial enclosure of the warming chamber;
the partial enclosure caused by the non-sealing engagement between the lips inhibiting moisture vapor produced from warm food disposed in the warming chamber from building up in the warming chamber, which prevents warm food disposed in the warming chamber from becoming soggy and allows enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

| | | |
|----------------------------|-----------|---------------|
| Anderson et al. (Anderson) | 4,919,300 | Apr. 24, 1990 |
| Stewart | 5,692,660 | Dec. 2, 1997 |
| Attaway | 5,775,530 | July 7, 1998 |
| Goryl | 5,967,390 | Oct. 19, 1999 |

Claims 1 to 13 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1 to 4, 8 to 10 and 14 to 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Attaway in view of either Stewart or Goryl.

Claims 5 to 7, 11 to 13 and 18 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Attaway in view of either Stewart or Goryl and further in view of Anderson.

Claims 5 to 7, 11 to 13 and 18 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Attaway in view of Anderson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 12, mailed January 28, 2003) and the answer (Paper No. 17, mailed November 14, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 16, filed July 3, 2003) and reply brief (Paper No. 18, filed January 16, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 1 to 13 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is

not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is not appropriate.

Furthermore, an appellant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 213-14, 169 USPQ 226, 228-29 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

The examiner's basis (final rejection, p. 2) for the rejection under 35 U.S.C. § 112, second paragraph, is that the phrases "constructed to define," "formed to provide," "formed to produce," "constructed to provide" and "constructed to inhibit" as used in claims 1 and 8 render claims 1 to 13 indefinite because it cannot be determined what structural feature or features, if any, these phrases require. We do not agree for the reasons set forth in the brief (pp. 6-13) which we adopt as our own. Suffice it to say, it is our opinion that the scope of the invention sought to be patented by claims 1 and 8 can clearly be determined from the language of the claims with a reasonable

degree of certainty.¹ Accordingly, the rejection of claims 1 to 13 under 35 U.S.C. § 112, second paragraph, is not appropriate.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 13 under 35 U.S.C. § 112, second paragraph, is reversed.

The obviousness rejections

We will not sustain the rejection of claims 1 to 20 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

¹ In that regard, breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

As set forth in the Manual of Patent Examining Procedure (MPEP) § 2141:

Office policy has consistently been to follow *Graham v. John Deere Co.*^[2] in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are briefly as follows:

- (A) Determining of the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Against this background, the obviousness or non-obviousness of the claimed subject matter under 35 U.S.C. § 103 must be determined.

Thus, initially, the scope and content of the prior art are to be determined. In the prior art rejections before us in this appeal (final rejection, pp. 2-4), the examiner did not set forth the scope and content of Attaway. The examiner did briefly set forth the scope and content of Stewart, Goryl and Anderson.

Secondly, the differences between the applied prior art (i.e., Attaway) and the claims at issue are to be ascertained. This the examiner has not done.

² Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966)

Thirdly, the examiner must determine if the ascertained differences between the subject matter sought to be patented and the combined teachings of the applied prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. The examiner has not determined that the actual differences between the subject matter sought to be patented and the combined teachings of the applied prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

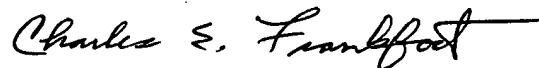
It is clear to us that the teachings of the applied prior art would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified the protective case of Attaway to arrive at the claimed subject matter for the reasons set forth by the appellant in the brief (pp. 14-23). In that regard, the applied prior art is not suggestive of the claimed non-sealing engagement between the lips which inhibits a build-up of moisture vapor produced from warm food disposed in the warming chamber for preventing warm food disposed in the warming chamber from becoming soggy and allows enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist as set forth in independent claims 1, 8 and 14.

For the reasons set forth above, the examiner has not established a prima facie case of obviousness and accordingly the decision of the examiner to reject claims 1 to 20 under 35 U.S.C. § 103 is reversed.

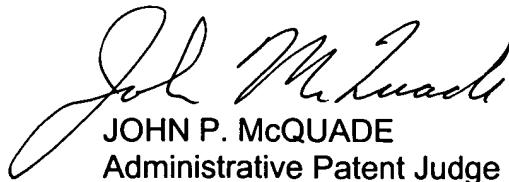
CONCLUSION

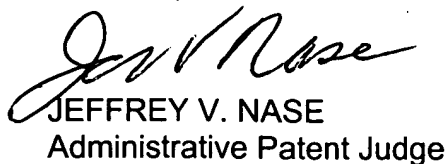
To summarize, the decision of the examiner to reject claims 1 to 13 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 1 to 20 under 35 U.S.C. § 103 is reversed.

REVERSED



CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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